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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,326	11/26/2003	Lingan Satkunanathan	MS302989.1	9470
27195. 7590 11/14/2007 AMIN. TUROCY & CALVIN, LLP 24TH FLOOR, NATIONAL CITY CENTER 1900 EAST NINTH STREET CLEVELAND, OH 44114			EXAMINER SHERR, CRISTINA O	
			ART UNIT 3621	PAPER NUMBER
			NOTIFICATION DATE 11/14/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket1@thepatentattorneys.com
hholmes@thepatentattorneys.com
osteuball@thepatentattorneys.com

Office Action Summary

Application No.

10/723,326

Applicant(s)

SATKUNANATHAN ET AL.

Examiner

Cristina Owen Sherr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-18 and 20-36 is/are pending in the application.
- 4a) Of the above claim(s) 10-17, 27-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 18 and 20-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to applicant's amendment filed August 17, 2007. Claims 1-7, 9-18, and 20-36 are currently pending in this case. Claims 1-7, 9, 18 and 20-26 are currently under examination.

Response to Arguments

2. Applicant argues, with respect to claim 1, that nothing in Christiano teaches, discloses or suggests a "license database that provides activation codes, an interface to facilitate communication between the license store and the license database and an activation code entered by a user to activate a license component as recited by the subject claims".

3. While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case we note that a "system is an apparatus." *Ex parte Fressola* 27 USPQ2d 1608, 1611 (B.P.A.I. 1993) (citations omitted). Additionally,

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"[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a 'machine.'" *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I.1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Therefore, it is the Examiner's position that Applicant's system claims are "product," "apparatus," or more specifically, "machine" claims.

4. In this case, we note that that a "wizard" is software. Thus "a license database interface component coupled to the wizard component" is software and therefore not a structure that will distinguish the instant application from the prior art.

5. Further, "an activation code entered by a user to activate a license component" is software, and therefore not a structure that will distinguish the instant application from the prior art.

6. Alternatively, with respect to claims 1 and 18, Examiner respectfully disagrees and directs attention to Christiano wherein "other steps well-known to those skilled in the art would be performed before and after step 54 to implement the license server" (col 10 ln 20-23), wherein the said other steps would include an activation code for activating or implementing a license. Further in Christiano "input/output components . . ." (col 10 ln 4-5) refer to a an interface between the license store and license database, where input/output components are known to include such items as keyboards, printers, and monitor screens.

Claim Rejections - 35 USC § 103

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-7, 9, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christiano (US 5,671,412) in view of Microsoft (Microsoft Hails 10 Years of Publisher Charges Toward New Decade With Microsoft Publisher Deluxe, REDMOND, Wash., Oct. 15, 2001 at <http://www.microsoft.com/presspass/press/2001/oct01/10-15TenYearsPublisherPR.mspx?pf=true>).

9. Regarding claim 1 –

Christiano discloses a system for adding or transferring licenses to a computer system comprising: a license database interface component that communicates with a license database, where an activation code is used (e.g. col 10 ln 10-25).

10. As above, Examiner respectfully directs attention to Christiano wherein “other steps well-known to those skilled in the art would be performed before and after step 54 to implement the license server” (col 10 ln 20-23), wherein the said other steps would include an activation code for activating or implementing a license. Further in Christiano “input/output components . . .” (col 10 ln 4-5) refer to a an interface between the license store and license database, where input/output components are known to include such items as keyboards, printers, and monitor screens.

11. Christiano does not disclose a wizard and graphical interface, where a component may be activated via the use of an activation code. Microsoft, however, does ("Publisher, the first desktop publishing program from Microsoft, introduced wizards, step-by-step instructional guides that walk users through the setup of almost any type of document and allow those without formal design training to make use of the application's professional-level tools. The concept quickly caught on, and wizards have since become common in Microsoft software and operating systems." (At 7th paragraph).

12. It would be obvious to one of ordinary skill in the art to combine the teachings of Christiano and Microsoft in order to make a more user-friendly license manager. Further, it would be obvious to adapt the wizard and graphical interface to a license manager or to any of a number of applications as is indeed being widely done.

13. Regarding claim 2 –

As above, Christiano does not disclose a wizard and graphical interface, where a component may be activated via the use of an activation code. Microsoft, however, does ("Publisher, the first desktop publishing program from Microsoft, introduced wizards, step-by-step instructional guides that walk users through the setup of almost any type of document and allow those without formal design training to make use of the application's professional-level tools. The concept quickly caught on, and wizards have since become common in Microsoft software and operating systems." (At 7th paragraph). Further, as above, Examiner respectfully directs attention to Christiano wherein "other steps well-known to those skilled in the art would be performed before

and after step 54 to implement the license server” (col 10 ln 20-23), wherein the said other steps would include an activation code for activating or implementing a license. Further in Christiano “input/output components . . .” (col 10 ln 4-5) refer to a an interface between the license store and license database, where input/output components are known to include such items as keyboards, printers, and monitor screens.

14. Regarding claim 3 –

Christiano discloses a system wherein the license code is indicative of the number of licenses to be added or transferred to a computer system (e.g. col 10 ln 20-40).

15. Regarding claim 4 –

Christiano discloses a system wherein the license database interface component receives the license code from the interface component and generates a corresponding activation code (e.g. col 12 ln 20-30).

16. Regarding claim 5 –

As above, Christiano does not disclose a wizard and graphical interface. Microsoft, however, does (“Publisher, the first desktop publishing program from Microsoft, introduced wizards, step-by-step instructional guides that walk users through the setup of almost any type of document and allow those without formal design training to make use of the application's professional-level tools. The concept quickly caught on, and wizards have since become common in Microsoft software and operating systems.” (At 7th paragraph). Further, as above, Examiner respectfully directs attention to Christiano wherein “other steps well-known to those skilled in the art would be performed before

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and after step 54 to implement the license server" (col 10 ln 20-23), wherein the said other steps would include an activation code for activating or implementing a license.

Further in Christiano "input/output components . . ." (col 10 ln 4-5) refer to a an interface between the license store and license database, where input/output components are known to include such items as keyboards, printers, and monitor screens.

17. It would be obvious to one of ordinary skill in the art to combine the teachings of Christiano and Microsoft in order to make a more user-friendly license manager. Further, it would be obvious to adapt the wizard and graphical interface to a license manager or to any of a number of applications as is indeed being widely done.

18. Regarding claim 6 –

Christiano discloses a system wherein license component stores license data including a quantity representing the number of licenses to be added or transferred to the license store (e.g. col 10 ln 20-30).

19. Regarding claim 7 –

As above, Christiano does not specifically disclose a wizard and graphical interface.

Microsoft, however, does ("Publisher, the first desktop publishing program from Microsoft, introduced wizards, step-by-step instructional guides that walk users through the setup of almost any type of document and allow those without formal design training to make use of the application's professional-level tools. The concept quickly caught on, and wizards have since become common in Microsoft software and operating systems." (At 7th paragraph).

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20. Regarding claim 9 –

Christiano does not specifically disclose receiving an activation code over the telephone. However, Christiano does disclose (e.g. col 6 ln 1-20) wherein the client computers are in communication with each other and with the license manager through a network. It is obvious that telephones a merely one type of network. Further, official notice is taken that receiving an activation code over the telephone. Is old and well known in the art.

21. Regarding claim 18 –

Christiano discloses a method for adding licenses to a computer system comprising: accepting a license agreement; indicating a method of contacting a license database; providing a license code identifying a particular license component; (e.g. col 10 ln 10-25).

22. As above, Christiano does not disclose a wizard and graphical interface.

Microsoft, however, does ("Publisher, the first desktop publishing program from Microsoft, introduced wizards, step-by-step instructional guides that walk users through the setup of almost any type of document and allow those without formal design training to make use of the application's professional-level tools. The concept quickly caught on, and wizards have since become common in Microsoft software and operating systems." (At 7th paragraph).

23. It would be obvious to one of ordinary skill in the art to combine the teachings of Christiano and Microsoft in order to make a more user-friendly license manager.

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Further, it would be obvious to adapt the wizard and graphical interface to a license manager or to any of a number of applications as is indeed being widely done.

24. Regarding claims 20- 21 –

Christiano discloses a method wherein one method of contacting a license database is using the Internet or the telephone (e.g. col 4 ln 10-55). As above, Christiano does not specifically disclose over the telephone. However, Christiano does disclose (e.g. col 6 ln 1-20) wherein the client computers are in communication with each other and with the license manager through a network. It is obvious that telephones a merely one type of network. Further, official notice is taken that communicating over the telephone is old and well-known in the art.

25. Regarding claim 22 –

Christiano discloses a method comprising providing an installation ID to the license database (e.g. col 5 ln 10-45).

26. Regarding claim 23 –

Christiano discloses a method wherein the number of digital licenses installed is related to license code associated with a license component (e.g. col 6 ln 10-35).

27. Regarding claim 24 –

Christiano discloses a method further comprising providing credit card information to facilitate purchasing a license component (e.g. col 3 ln 35-55).

28. Regarding claim 25 –

Christiano discloses a method wherein a purchased license component is downloaded from a web site (e.g. col 3 ln 35-55).

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29. Regarding claim 26 –

Christiano discloses a computer readable medium having stored thereon computer executable instructions for carry out the method of claim 18 (e.g. col 3 ln 35-55).

30. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

31. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Rivera et al (US 6056786)
- Coley et al. (US 5790664)
- Colvin (US 6799277)
- Meyer(US 6810389)

32. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

33. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571-272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

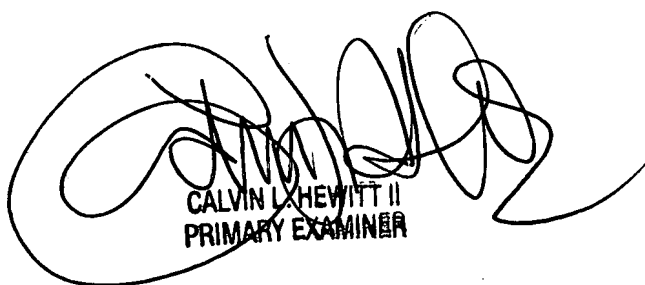
35. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cristina Owen Sherr
Patent Examiner, AU 3621



CALVIN L. HEWITT II
PRIMARY EXAMINER